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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/682,901 | 10/31/2001 | Werner Lindemann | 112740-350 | 2923 |
| 29177 | 7590 | 08/26/2004 | EXAMINER | |
| BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135 | | | AILES, BENJAMIN A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2142 | |

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/682,901 | Applicant(s) LINDEMANN ET AL. | |
| | Examiner Benjamin A Ailes | Art Unit 2142 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-15 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 100 53 951.3, filed on October 31, 2000. However, in order to receive benefit of foreign filing date, a statement that the English translation of the certified copy is accurate must be submitted.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7, and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bhatia et al. (U.S. 6,118,768).
5. As per claim 1, Bhatia et al. teach a method for setting up a connection via an IP-oriented network comprising the steps of:
 - connecting a device... (column 10, lines 19-23).
 - connecting the local computer network... (col. 10, lines 28-33).
 - connecting the communications network... (col. 10, lines 28-33).
 - selecting one of the conversion devices... (col. 5, line 62-col.6 line 8).
 - setting up a communications link... (col. 10, lines 28-33).

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6. As per claim 2 in accordance with claim 1, Bhatia et al. teach a method wherein the selected conversion device is a default conversion device... (col. 5, lines 43-55).

7. As per claim 3 in accordance with claim 1, Bhatia et al. teach a method for setting up a connection further comprising the steps of initializing a connection setup...and transferring the information originating from a second application... (col. 5, lines 40-46 and col. 11, lines 43-53).

The examiner has interpreted this claim as the technology in order to maintain two different workstations connections to either the same or different conversion devices.

8. As per claim 4 in accordance with claim 3, Bhatia et al. teach a method a method for setting up a connection wherein the information is transferred via a separate connection...(col. 4, lines 45-51).

9. As per claim 5 in accordance with claim 1, Bhatia et al. teach setting up a connection via an IP-oriented network comprising the step of:

-transmitting automatically, via the selection unit, a request message to the device... (col. 4, line 66-col. 5 line 4).

10. As per claim 7 in accordance with claim 1, Bhatia et al. teach a setting up a connection method further comprising automatically clearing down an existing communications connection...(col. 34, lines 58-65). Examiner interprets the claim language as saying a communications connection is terminated after a period of time, including a period of inactivity or idleness.

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11. As per claim 9 in accordance with claim 1, Bhatia et al. teach setting up a connection comprising:

- designing the selection unit according to a Domain Name Service proxy... (col. 6, lines 9-14).

- forwarding the Domain Name Service enquiry... (col. 6, lines 25-33).

12. As per claim 10 in accordance with claim 2, Bhatia et al. teach:

- the transferred information is an IP address (col. 5, lines 16-17) and,

- an IP address specifically set up in the selection... (col. 5, lines 17-26).

13. As per claim 11 in accordance with claim 10, Bhatia et al. teach a method for setting up a connection via an IP-oriented network comprising the step of:

- routing IP addresses subsequently... (col. 12, lines 7-16).

14. As per claim 12, Bhatia et al. teach a router device comprising:

- a selection unit for selecting one of the conversion devices... (col. 5, line 62-col.6, line 8).

- a control unit for subsequent set-up of a communications connection... (col. 4, line 64-col. 5, line 10).

15. As per claim 13 in accordance with claim 12, Bhatia et al. teach the use of a router device wherein the selection unit is a server, a separate socket connection being provided...(col. 4, lines 64-66).

16. As per claim 14 in accordance with claim 12, Bhatia et al. teach the use of a router device wherein the selection unit is designed according a Domain Name Service proxy (col. 5, line 66-col. 6, line 8).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia et al. (U.S. 6,118,768) in view of Guerin et al. (U.S. 6,243,754).

19. As per claim 6, Bhatia teaches the use of a default conversion device, but fails to teach the method of configuring the selection unit as a function of time of day. However, Guerin et al. disclose a router that determines an appropriate conversion device based on performance or cost characteristics (col. 3, lines 9-20). The function of time of day is considered a cost characteristic as described by Guerin et al. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to associate a function in order to utilize the most cost efficient available conversion device.

20. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia et al (U.S. 6,118,768) in view of Duvall et al. (U.S. 5,884,033).

21. As per claim 15, Bhatia teaches the use of a router but fails to teach the use of an IP address filter. However, Duvall et al. disclose a filtering system used in order to ALLOW or BLOCK incoming or outgoing transmissions (col. 4, lines 22-36). It would have been obvious to one of ordinary skill in the art at the

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time of applicant's invention to use an IP address filter in order to control the incoming and outgoing of messages.

22. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia et al (U.S. 6,118,768). Bhatia et al. fail to not clear down a different device connected to the local computer network when a conversion device terminates another connection. However, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize this technology because it is reasonable to not terminate an active connection based on a separate entity's inactivity.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Driscoll et al. (U.S. 6,577,627) disclose a service selection on IP access networks.

Hughes et al. (U.S. 6,065,055) disclose inappropriate site management software.

West et al. (U.S. 6,081,508) disclose a remote computer communication device.

Bhagavath et al. (U.S. 2002/0002615 A1) disclose a method and apparatus for switching between Internet service provider gateways.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is

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703-305-0447. The examiner can normally be reached on Monday-Friday (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached at (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is (703)308-5358.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [benjamin.ailles@uspto.gov].

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Group receptionist whose telephone number is (703)305-3900.

baa


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER